

REMARKS

Claims 1-7, 9, 10, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,226,628 issued to Forbes (hereinafter "Forbes") in view of U.S. Patent Number 6,493,709 issued to Aiken (hereinafter "Aiken"). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Forbes and Aiken and in further view of U.S. Patent Number 6,535,873 issued to Fagan et al. (hereinafter "Fagan"). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Forbes and Aiken in view of U.S. Patent Number 5,414,850 to Whiting (hereinafter "Whiting"). Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Forbes and Aiken in view of Applicant's admitted prior art.

Claim 12 is canceled. Claims 1 and 10 are amended with the limitations of canceled claim 12 to more particularly point out and distinctly claim the subject matter of the claimed invention. In addition, claim 14 is amended with the limitations of canceled claim 12 and claims 2 and 3. Claim 11 is amended to correct an informality. The amendments are fully supported by the specification and introduce no new material to the claims.

Response to rejections of claims 1-7, 9, 10, 12, and 14 under 35 U.S.C. § 103(a)

Claims 1-7, 9, 10, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Forbes in view of Aiken. Applicant respectfully traverses these rejections. Because the claims 1, 10, and 14 are amended with the limitations of claim 12, the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Forbes and Aiken in view of Applicant's prior art is also traversed.

It is well settled that the PTO has the burden to establish a *prima facie* case of obviousness. *In re Glaug*, 2002 U.S. App. Lexis 4246, *4 (Fed. Cir. March 15, 2002); MPEP §2142. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP §2143.03 (emphasis added). The Federal Circuit has held that “the ‘subject matter’ that must have been obvious to deny patentability under §103 is the entirety of the claimed invention,” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 (Fed. Cir. 1987). Furthermore, even if all the claim limitations are taught or suggested, there must be some suggestion or motivation to combine reference teachings. *See* MPEP §2142. Applicant respectfully asserts that a *prima facie* case of obviousness has not been made because not all the elements recited in the claims are taught or suggested by the prior art and there is no teaching or suggestion in the art to produce the claimed invention.

The legal and PTO framework for determining claim term meaning is clear. First, “[c]laims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’.” *In re Marosi*, 710 F.2d 799, 802 218 USPQ 289 292 (Fed. Cir. 1983). Second, “[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). MPEP §2111. And third, “[t]he words of a claim must be given their ‘plain meaning’ unless they are defined in the specification. “[P]lain meaning” refers to the meaning given to the term by those of ordinary skill in the art” MPEP §2111.01. Therefore, the claim term fitness value is to be interpreted in light of the specification and consistent with an interpretation those of skill in

the art would give the term. Furthermore, where a term is defined in the specification that definition should control the interpretation.

With regards to claims 1, 10, and 14 as amended with the limitations of claim 12, the Examiner has not made a *prima facie* case that includes each element claimed by the present invention. Specifically, claim 10 as amended claims "a publish/subscribe engine connected for communication between application programs and said controller components for analyzing contents, deleting duplicates and generating indexes, wherein the publish/subscribe engine enables the application programs to register as publishers and as subscribers for information and is adapted to compare information components created by a first application program with other application programs' subscriptions, and then to notify identified subscriber applications when a created information component matches an application program's subscriptions." Claim 10 as amended. Claims 1 and 14 as amended include similar limitations without reference to the publish/subscribe engine. Applicants assert that the publish/subscribe engine of amended claim 10 and the limitations associated with the publish/subscribe engine of amended claims 1 and 14 are not admitted prior art. The publish/subscribe engine and associated limitations are only found in the description of an embodiment of the present invention. Paragraph 38. See also paragraphs 38, 43, and 44. As described, the publish/subscribe engine is an element of the embodiment of the present invention and is not prior art. In addition, neither Forbes nor Aiken teaches the publish/subscribe engine. Absent such each element of the embodiment of the claimed invention, Applicants respectfully assert that claims 1, 10, and 14 of the present invention cannot be obvious over Forbes in view of Aiken and are allowable.

With regards to claim 14, the claim as amended includes the limitations of claims 2 and 3. In particular, claim 14 as amended includes the limitations “means for analyzing the contents of the set of files... *in response to a saving of the file* and analyzing the contents of said information components to identify duplicates *by a background process independently of user-controlled operations;*” and “deleting duplicate components from the information repository *by a background process independently of user-controlled operations...*” Claim 14 as amended, italics added for emphasis.

In contrast, neither Forbes nor Aiken teaches analyzing the contents of the set of the set of files in response to a saving of the file, identifying duplicates by a background process, or deleting duplicates by a background process. Instead, Forbes teaches saving files and in a computer system. Forbes, Fig. 1, ref. 20, col. 4 lines 20-40. Because neither Forbes nor Aiken teach each element of the claimed invention, Applicants assert that claim 14 is allowable.

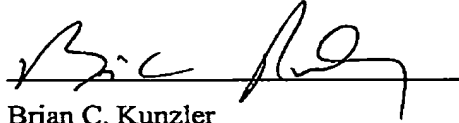
With further regards to claims 1, 10, and 14, the Examiner has not made a *prima facie* case that includes a suggestion or teaching to combine the shredding search disclosure of Aiken with the cross-file compression teaching of Forbes. Aiken, abstract. Forbes, abstract. In particular, there is no suggestion to combine indexing data as disclosed by Aiken with the teaching of Forbes. Aiken, col. 5, line 36 – col. 6, line 31. Cross-file compression has a very different application and scope from a shredding search. Without some teaching or suggestion to combine, a skilled artisan would not be motivated to combine the teachings of Forbes and Aiken. In addition, Aiken teaches away from the compression function of Forbes by suggesting that non-query files without similarity to the query file be deleted, while Forbes teaches that instances

of non-similar data are preserved. Aiken, abstract. Forbes, col. 7, lines 1-9. Because neither Forbes nor Aiken include a teaching or suggestion to combine the disclosure of Aiken with Forbes and because Aiken teaches away from Forbes, Applicants therefore assert that claims 1, 10, and 14 cannot be unpatentable over Forbes in view of Aiken and are allowable.

As a result of the presented remarks, Applicants assert that independent claims 1, 10, and 14 are in condition for prompt allowance. Applicants have not specifically traversed the rejections of dependent claims 2-9, 11, and 13 under 35 U.S.C. 103(a), but believe those claims to be allowable for depending from allowable claims. See, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Should additional information be required regarding the traversal of the rejections of the dependent claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,



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